

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAVAUGHN F. WATTS, JR.

Appeal No. 1997-3820
Application 08/336,040¹

Before MARTIN, FLEMING, and RUGGIERO, Administrative Patent Judges.

MARTIN, Administrative Patent Judge.

DECISION ON RECONSIDERATION

Appellant has requested reconsideration of our August 28, 2000, decision (hereinafter "Decision") to the extent we affirmed the examiner's 35 U.S.C. § 103 rejection of claim 11

¹ Application for patent filed November 8, 1994.

and its dependent claims 12-18.² As appellant correctly notes, claim 11, which reads as follows, requires that the determining means be located within the computer docking station:

11. A computer docking station, comprising:

connection means for coupling to an external monitor and an external keyboard, and means for connecting a portable computer to said docking station; and

means for determining whether or not said external monitor is coupled to said docking station, automatically displaying on said external monitor and disabling the monitor of the portable computer when said external monitor is coupled to said docking station and displaying on the display of said portable computer when said external monitor is not coupled to said docking station. [Emphasis added.]

We agree with appellant's implication that claim 11 is narrower in this respect than the other independent claims, whose rejection for obviousness over Mesfin in view of Nishigaki we also affirm. Claims 1 and 2,³ for example, each

² We affirmed the rejection of claims 11-14 over Mesfin in view of Nishigaki and the rejection of claims 15-18 over Mesfin in view of Nishigaki and Swindler. Therefore, at page 11, line 11, of the Decision, the phrase "The rejection is affirmed" should read "The rejections are affirmed."

³ Reproduced in Decision at 3.

recite a computer docking system comprising a portable computer, docking station, and determining means without specifying the location of the determining means. Appellant contends that because claim 11 requires the determining means to be located within the docking station, our affirmance of the rejection of that claim is inconsistent with our stated assumption that the examiner is proposing to locate Nishigaki's keyboard controller and selector 41 within Mesfin's portable computer. Specifically, in addressing claim 2, which calls for determining whether an external keyboard is coupled to the docking station, we held that

[b]ecause Nishigaki's common keyboard controller 23 and selector 41 are located within the laptop computer, we assume the examiner intends to locate both of these components in Mesfin's laptop computer as well, in which case an external keyboard, when connected to the docking station, will be connected therethrough to the external keyboard connector of the laptop computer. [Decision at 8.]

Furthermore, regarding claim 2, which like claim 11 calls for the determining means to determine whether an external monitor is coupled to the docking station, we noted (Decision at 8-9) that appellant's brief fails to explain why the examiner was

incorrect to conclude that it would have been obvious to extend Nishigaki's automatic external-keyboard detection technique to the detection of an external monitor.

Appellant's argument on reconsideration appears to be that claim 11 is satisfied only if it would have been obvious to locate the monitor controller and the monitor selector (analogous to Nishigaki's keyboard controller 23 and keyboard selector 41) within Mesfin's docking station. We do not agree. In our view, the "means for determining" limitation is broad enough to read on a docking station which contains apparatus for (a) determining whether or not an external monitor is connected to the docking station and (b) issuing a signal representing the result of this determination to a portable computer which contains circuitry responsive to such a signal for causing a display to appear on the external monitor when one is present and otherwise on the display device of the portable computer. Nevertheless, because the examiner has failed to adequately explain why it would have been obvious to provide Mesfin's docking station with circuitry which determines whether an external monitor is

coupled thereto, we are reversing the rejections of claim 11 and its dependent claims 12-18.

The combined effect of our initial decision and this decision on reconsideration is that (a) the § 103 rejection based on Mesfin in view of Nishigaki is affirmed with respect to claims 1-6, 9, 10, and 19-22 and reversed with respect to claims 11-14, (b) the § 103 rejection based on Mesfin in view of Nishigaki and Swindler is affirmed with respect to claim 7 and reversed with respect to claims 8 and 15-18, and (c) a new § 103 rejection

of claim 8 based on Mesfin in view of Nishigaki and Mitcham has been entered pursuant to 37 CFR § 1.196(b).

RECONSIDERATION GRANTED

JOHN C. MARTIN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	

Appeal No. 1997-3820
Application 08/336,040

JOSEPH F. RUGGIERO)
Administrative Patent Judge)

JCM:lmb

Appeal No. 1997-3820
Application 08/336,040

Ronald O. Neerings
Texas Instruments Incorporated
M/S 219
P.O. Box 655474
Dallas, TX 75265